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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,041	12/21/2001	Mary M. DaRif	6962	8619
The Sherwin-Williams Company Legal Dept. 11 Midland Bldg. 101 Prospect Avenue, N.W. Cleveland, OH 44115			EXAMINER HOGE, GARY CHAPMAN	
			ART UNIT 3611	PAPER NUMBER
			MAIL DATE 09/19/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/026,041

Applicant(s)

DARIF ET AL.

Examiner

Gary C. Hoge

Art Unit

3611

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 8, 10-12 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Hallock (688,997).

Hallock discloses a paint color card A comprising a substrate having a first surface that has a surface area that is coated in its entirety with a layer of a first colored coating composition formulated to have a dried color that is substantially similar to dried color of a commercially-available paint composition, the paint color card having formed therein a plurality of perforations defining a detachable chip section E. The chip section is detachable because it is easily torn off.

Regarding claims 8 and 25, chip section E constitutes a second surface.

Regarding claim 12, when the tear lines are severed, the chip section may be detached from the paint color card by tearing it off.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
5. Claims 3, 13, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hallock (688,997).

Regarding claims 3 and 13, Hallock discloses the invention substantially as claimed, as set forth above. However, the chip section is rectangular, rather than square. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the chip section disclosed by Hallock square because it has been held that changes in the shape of an article are a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed article is significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Regarding claim 27, Hallock discloses the invention substantially as claimed, as set forth above. However, it is not known what the length-to-width ratio of the card is. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the length-to-width ratio of the card disclosed by Hallock greater than about 1 and less than about 4 because it has been held that changes in the shape of an article are a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the

particular configuration of the claimed article is significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Regarding claim 28, Hallock discloses the invention substantially as claimed, as set forth above. However, it is not known what the ratio of the length of the tear line that forms the chip section to the width of the card is. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make that ratio between about 0.2 to about 0.8 because it has been held that changes in the shape of an article are a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed article is significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

6. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hallock (688,997) in view of Williams (5,743,407).

Hallock discloses the invention substantially as claimed, as set forth above. However, it is not known whether the cards are made of paper. Because it is within the level of ordinary skill of a worker in the art to select from among known materials on the basis of their suitability for the fabrication of a given device, and because Williams teaches that paper would be suitable for the fabrication of a paint sample card (column 1, lines 22-25), it would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the card disclosed by Hallock from paper, as taught by Williams, as a matter of choice in design, based on such factors as cost and availability of the materials to the designer.

7. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hallock (688,997) in view of Schaffer et al. (4,253,259).

Hallock discloses the invention substantially as claimed, as set forth above. However, it is not known whether the cards include indicia. Schaffer teaches that it was known in the art to provide indicia on the back of a swatch card, the indicia providing information about the swatch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide indicia on the back of the swatch card disclosed by Hallock, as taught by Schaffer, in order to provide information about the swatch. The precise content of the indicia is not patentably significant.

8. Claims 9 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hallock (688,997) in view of Goldsholl (3,224,113).

Hallock discloses the invention substantially as claimed, as set forth above. However, it is not known whether the cards included paint samples on both sides. Goldsholl teaches that it was known in the art to provide different colored paint samples on both sides of a card, in order to “provide means for displaying a maximum number of colors in a minimum amount of space” (column 3, lines 49-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide different colored paint samples on both sides of the card disclosed by Hallock, as taught by Goldsholl, in order to provide means for displaying a maximum number of colors in a minimum amount of space.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gary C. Hoge/
Primary Examiner, Art Unit 3611